

**REMARKS**

The Office Action dated October 04, 2005, has been reviewed and the Examiner's comments carefully considered. Prior to this paper, claims 1-20 were pending, with claims 8, 9 and 12-19 being withdrawn. By this paper, Applicants incorporate the subject matter of claim 2 into claim 1 and cancel claim 2 (thus effectively placing claim 2 into independent form), and add claim 21. Therefore, claims 1 and 3-21 are now pending.

Applicants respectfully submit that the present application is in condition for allowance for at least the reasons that follow.

**Rejections Under 35 U.S.C. §112, Second Paragraph**

In the Office Action, claims 1-7, 10-11 and 20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite; all of these claims being rejected for reasons relating to recitations present in claims 1 and 20, with claims 10 and 11 being rejected for additional reasons.

In response, in order to advance prosecution, and without prejudice or disclaimer, Applicants amend claim 10, and submit that the indefiniteness rejections peculiar to these claims are now moot in view of the amendment to claim 10. Specifically, claim 10 now recites "a border line connecting **respective** points at which tangent lines on a front surface of the outer panel and the ground form 90 degree angles." An exemplary embodiment of the invention of claim 10 may be seen in Fig. 2 of the specification, where two points 6, two tangent lines 7 and a border line 8 connecting the two points 6 may be seen.

In regards to the rejection of the independent claims, Applicants respectfully traverse the first underlying rationale proffered in the Office Action to the extent that such rejections would be extended to the claims of the current claim set, after the above proffered amendments, for the following reasons.

In rejecting the independent claims for indefiniteness, the Office Action asserts that it "is not understood how the function for heat dissipation is possible 'by providing a heat insulation section to insulate heat for the at least one surface.'" This assertion ignores the

language that was immediately precedent the quoted claim recitations that the structure “has both functions of heat insulation and heat dissipation by partially providing a heat insulation section . . . .” (Emphasis added.) That is, through the use of partial insulation, heat dissipation and heat insulation is realized. Pages 6-8 and Fig. 1 of the specification provide an exemplary description of the physical phenomenon that takes place to achieve this result. Moreover, pages 13-14 and Figs. 3a-4c, among other sections of the specification, provide exemplary embodiments implementing the inventions of claims 1 and 20.

Thus, in view of the language of the claims and the teachings of the specification, Applicants respectfully submit that the ordinary artisan would not have found claims 1 and 20, and the claims that depend therefrom, prior to the above amendments, indefinite, and thus by extension would not find the present claims indefinite. Reconsideration is respectfully requested with respect to this first reason for rejecting claims 1 and 20.

Regarding the second rationale for rejecting claims 1 and 20 (alleged lack of clarity as to “where the ‘heat insulation section’ and the ‘heat insulation means’ are provided”), Applicants have amended claim 1 to include the subject matter of claim 2 (essentially placing claim 2 into independent form) and have made similar amendments to claim 20. Applicants submit that the second ground for rejection of claims 1 and 20 is now moot in view of this amendment.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-3, 10-11 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by FR 2606712. In response, in order to advance prosecution, and without prejudice or disclaimer, Applicants have made the above clarifying amendments to claim 1, and respectfully submit that the above claims are allowable for at least the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It is respectfully submitted that FR 2606721 does not describes each and every element of any pending claim.

**Claim 1:** Claim 1, as amended, recites that the “panel includes partial heat insulation to insulate the at least one surface in addition to the structure of the respective outer panel, inner panel and trim, to provide both functions of heat insulation and heat dissipation.” (Emphasis added.) That is, the heat insulation is a feature in addition to the structure of the respective panels/trim. An exemplary embodiment of the present invention may be seen in Figs. 3a-4c, where heat insulation component 5 is an additional component with respect to the panels 1, 2 and trim 3.

In contrast, FR 2606721 merely teaches, at most (assumed *arguendo*), a motor vehicle body section with outer and inner panels. There is no partial insulation present in FR '721 that is in addition to the structure already present. Indeed, the Office Action relies on an inherency argument to meet the recitations relating to insulation: “outer panel 4 *inherently* function[s] as a heat insulator in that it holds heat within the door . . . to a certain degree.” That is, the Office Action premises its rejection of the prior pending claims solely on an allegation that structure that is not a perfect conductor / perfect radiator is an insulator in the most loose definition of the word. (This is analogous to arguing that, for example, that a steam pipe comprising only its steel body is insulated.) The Office Action does not point to any insulating section beyond that which is present in any vehicle structure. Regardless, claim 1, as amended, now affirmatively recites partial heat insulation in addition to the structure of the vehicle. Because FR '721 does not teach, either expressly or inherently, such features, claim 1 and its dependencies are not anticipated by FR '721.

**Claim 20:** Claim 20 recites a vehicle body panel structure wherein “wherein at least one surface of a back surface of the outer panel, both surfaces of the inner panel, and a surface of the trim facing the outer panel includes a partial heat insulation means for providing the vehicle body panel structure with both functions of heat insulation and heat dissipation for insulating the at least one surface.” (Emphasis added.)

Applicants respectfully submit that FR '721 does not teach a means for insulating heat, as claim 20 is interpreted under 35 U.S.C. §112, 6<sup>th</sup> paragraph, in view of the teachings of the specification. The rejections outlined in the Office Action in view of claim 20 do not

comport with the requirements of MPEP §2183 for examining claims under 35 U.S.C §112, 6<sup>th</sup> paragraph, which states that if “the examiner finds that a prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means- (or step-) plus function limitation, *the examiner should provide an explanation and rationale in the Office Action as to why the prior art element is an equivalent.*” (Emphasis added.)

In the Office Action, the use of means-plus-function language is not addressed. Indeed, claim 20 is simply lumped in the rejection of claim 1 as if it was the same claim, which it is not. As noted with respect to claim 1, the specification teaches that Applicants invention utilizes insulation that is in addition to the vehicle structure, and thus claim 20 necessarily covers this feature. Further, the specification does not teach utilizing mere vehicle structure as an insulator to achieve heat insulation. Thus, the teachings of FR '721 are clearly not the same as those presented in the specification. Therefore, equivalence must be shown per MPEP §2183, else claim 20 allowed.

In sum, FR '721 does not anticipate any pending claim.

#### **Claim Rejections Under 35 U.S.C. §103(a)**

In the Office Action, Claims 4-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over FR '721 in view of JP2001158306. Applicants respectfully traverse the rejection as to the claims above, and submit that these claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference

(or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As noted above, claim 1 stands amended to recite that the “panel includes partial heat insulation . . . in addition to the structure of the respective outer panel, inner panel and trim, to provide both functions of heat insulation and heat dissipation” (emphasis added), and FR ’721 does not anticipate this feature. JP 2001158306 does not remedy the deficiencies of FR ’721, and thus even if the first requirement of MPEP § 2143 is satisfied (which it is not), the third requirement of MPEP § 2143 is not satisfied in the Office Action, at least with respect to claim 1, since the cited references do not teach each and every element of the present invention. Moreover:

Claims 4 and 5 recite adhesive. The Office Action does not point to where JP ’306 teaches adhesive. Thus, the third requirement is not met with respect to these claims for additional reasons.

Claims 6 and 7 recite a painted coating material. No such teachings appears to be present in JP ’306, and even if claims 6 and 7 continue to be interpreted as product-by-process claims, despite the above proffered amendments, no evidence has been proffered by the PTO that the product of JP ’306 is the same as that resulting from the alleged process claimed – a requirement of the case law presented in the Office Action to substantiate the rejection of these claims. In fact, just the opposite is the case: painting aluminum flakes onto

a structure would result in a different product than, for example, laying “leafing aluminum” over a structure.

In sum, the third requirement of MPEP § 2143 is not satisfied in the Office Action with respect to claims 4-7, and a *prima facie* case of obviousness has thus not been established.

Lack of Suggestion or Motivation to Modify or Combine the References

MPEP § 2143.01 states that “the prior art *must* suggest the desirability of the invention.” (MPEP § 2143.01, subsection 1, emphasis added.) It is respectfully submitted that the Office Action does not provide a rationale as to why one of ordinary skill in the art would have been motivated to modify any of the references, and thus a *prima facie* case of obviousness has not been established.

True, the Office Action states a result of general implementation of the teachings of JP 2001158306. (*i.e.*, using aluminum flakes of JP ’306 results in “heat shielding function.”) However, Applicants respectfully submit that a *result* is not the same as a *reason why* one of ordinary skill in the art would be motivated to combine the references, however desirable those results may be. If motivation to combine references to establish a *prima facie* case of obviousness could merely be satisfied by a result-oriented analysis of the prior art, the first requirement (and second requirement) of MPEP § 2143 would be completely vitiated. This is because by identifying references that teach each individual element of a claimed invention, implementation of the teachings of the cited references almost always necessarily provides results according to a given invention under examination. Indeed, such an analysis relies on impermissible circular reasoning.

In contrast to the result-oriented analysis proffered in the Office Action, the MPEP specifically states that “the prior art must suggest the desirability of the claimed invention.” The Office Action, in relying only on results, does not identify where the prior art suggests the desirability of utilizing heat insulation comprising low emissivity film having a low emissivity in a far-infrared region with an adhesive according to claims 4 and 5, and painting

a coating material which reduces emissivity of a painted surface in a far-infrared region according to claims 6 and 7.

In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

### **Request for Rejoinder of Withdrawn Claims**

Claims 8, 9 and 12-19 stand withdrawn. Applicants note that these claims depend either directly or ultimately from claim 1. Applicants respectfully request that these claims be rejoined and allowed due to their dependency from claim 1, a claim that is allowable. Applicants respectfully submit that no significant burden is placed on the PTO by rejoining and examining these claims. Indeed, such action is concomitant with the indication that “upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.”

### **New Claims**

As seen above, Applicants have added new claim 21. Claim 21 is allowable at least for the reasons that make claim 20 allowable, and for the additional reason that none of the cited references teach that “the partial heat insulation means is in addition to the structure of the respective outer panel, inner panel and trim.” Allowance is requested.

### **Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

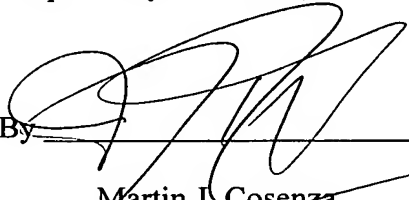
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Pape is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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